

REMARKS

Applicant acknowledges with appreciation the Examiner's indication that Claims 10 and 14 will be allowed if antecedent concerns are addressed. With this response, Claims 10 and 14 have been amended to address those concerns. In view of the amendments presented herewith, it is urged that Claims 10 and 14 (and such claims as depend therefrom) are now in good form for prompt allowance.

With this response, Claims 1, 17, 24 and 40 also have been amended to address other 35 USC 112 concerns raised by the Examiner. It is urged that Claims 1, 17, 24 and 40 (and such claims as depend therefrom) are now in good form for prompt allowance.

Reconsideration of the 35 USC 103 rejections of Claims 1, 17, 24 and 40 (and of such claims as depend from these independent claims and which are also subject to the same rejections) is respectfully requested in view of amendments made herewith to Claims 1, 17, 24 and 40. The amendments place better emphasis on the fact that Applicant's claimed paint shield protectively covers a "downwardly facing front face of a lens of a lighting fixture"<sup>1</sup> by utilizing a "relatively stiff material that resists sagging under the influence of gravity,"<sup>2</sup> that is sufficiently "pliable to permit central portions thereof to flex away from the front face of the lens" so that

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<sup>1</sup>No "new matter" issues are raised by the inclusion in Claims 1, 17, 24 and 40 of language calling for a "downwardly facing front face" inasmuch as this language finds support in Applicant's specification at page 12, line 22, et seq.

<sup>2</sup>No "new matter" issues are raised by the inclusion in Claims 1, 17, 24 and 40 of the language "resists sagging under the influence of gravity" inasmuch as this language finds support in Applicant's specification at page 13, line 12, et seq.

other portions can be inserted between an "upwardly facing surface of a frame"<sup>3</sup> and portions of the front face of the downwardly facing lens to thereby "hold the paint shield in place" during painting of the frame.

Although Applicant's and Panitzsch's paint shields are both intended to protectively cover areas that are not to be painted during painting of adjacent areas, Applicant's and Panitzsch's paint shields nonetheless serve very different purposes and cannot be used interchangeably. As is stated at the beginning of Applicant's specification:

The present invention relates to paint shields formed from relatively stiff but pliable material configured to protectively cover the transparent or translucent lenses of light fixtures so that frame components of the fixtures which extend perimetrically about the lenses can be painted by brush, by roller or by spray without getting paint on the lenses.

This is quite different from the purpose served by the paint shield of Panitzsch, which, as stated in lines 42-46 of page 1, is "to protect the frame against having paint or other decorative material applied to the frame during application thereof to the walls surrounding the frame." In other words, Applicant's paint shield permits the frame surrounding a protected area to be painted, while Panitzsch shield prevents the frame that surrounds the protected area from being painted (i.e.,

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<sup>3</sup>No "new matter" issues are raised by the inclusion in Claims 1, 17, 24 and 40 of the language "upwardly facing surface" inasmuch as this language finds support in Applicant's specification at page 12, line 24, et seq.

Panitzsch includes the frame in the area that is to be protected from being painted).

To permit the frame surrounding a protected area to be painted, Applicant's paint shield is designed to have its edge portions inserted behind portions of the frame (i.e., between upwardly facing portions of the frame and peripheral portions of the downwardly facing lens) that surround the protected area. Applicant's paint shield permits paint to be applied to the entire front face of a frame that surrounds an area to be protected from painting so that the juncture between what becomes painted and what is protected is defined by the inner edge of the frame.

To prevent the frame that surrounds a protected area from being painted, edge portions of the shield of Panitzsch extend across, overlie and are nailed into the front face of the frame that surrounds the protected area. Panitzsch's paint shield is nailed in place atop the front face of a frame so that the juncture between what becomes painted and what is protected is defined by the outer edge of the frame.

This significant difference in purposes is necessarily related to a significant difference in orientation in which Panitzsch's and Applicant's paint shields are installed when used. Panitzsch essentially discloses a paint shield that is intended to be installed in a vertical mode that allows the material of Panitzsch's paint shield to be flexible enough for Panitzsch's paint shield to be rolled up for compact transport and storage. Panitzsch does not teach a paint shield that is made of a material that is stiff enough to avoid sagging under the influence of gravity, which is a requirement of Applicant's paint shield, which is necessarily installed in a horizontal orientation when portions of Applicant's paint shield are inserted between peripheral portions of a

"downwardly facing front face of a lens" and an "upwardly facing surface of a frame."

Whereas Panitzsch's paint shield is able to make use of the influence of gravity to maintain its vertical orientation, Applicant's paint shield must resist the influence of gravity to maintain its horizontal orientation; and when the requirement that portions of Panitzsch's paint shield are able to be rolled up is taken into account, it becomes clear that Panitzsch's and Applicant's paint shields require materials of differing characteristics.

An honest reading of Panitzsch reveals that the one and only disclosed means of holding Panitzsch's paint shield in place when installed is nailing pins into a frame to be covered. There is no teaching or suggestion of any other means of holding the Panitzsch paint shield in place when installed, and so there is no teaching or suggestion of edge portions of the Panitzsch's paint shield being inserted between an "upwardly facing surface of a frame" and peripheral portions of a "downwardly facing surface of a lens" so as to extend between a frame and the lens to be held in place therebetween. Indeed, there is no teaching or suggestion in Panitzsch of inserting any portion of Panitzsch's paint shield between any two objects of any kind or for any reason.

Applicant respectfully traverses the Examiner's assertion about the removability of the so-called "pin strip" of Panitzsch. A careful reading of Panitzsch reveals that it would be necessary to destroy Panitzsch's paint shield to remove the "pin strip" from Panitzsch's paint shield. This is because the pins 15 are carried by members 11, 12, which are permanently attached to flexible shields 16, 17 (the Examiner's attention is respectfully drawn to lines 4-12 of page 2 describing a permanent connection to "bind" each of members 11, 12 to

corresponding ones of flexible shields 16, 17 "against separation"). Just as there is no teaching or suggestion to use any form of installing Panitzsch's paint shield in place other than by nailing pins into a frame, there is no teaching or suggestion to tear apart the permanent connections between the members 11, 12 and corresponding ones of flexible shields 16, 17.

Because independent Claims 1, 17, 24 and 40, as amended herewith, clearly bring out significant differences in construction, choice of material and use between the Panitzsch paint shield and Applicant's claimed invention, as discussed above, it is urged that the 35 USC 103 rejections of independent Claims 1, 17, 24 and 40 (and the claims that depend therefrom and against which the same rejections have been made) be reconsidered and withdrawn, and that all of the active claims be allowed.

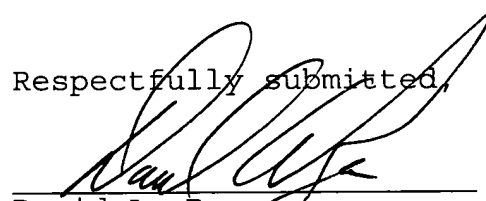
If the Examiner should find any remaining issues or concerns that perhaps can be resolved by telephone, the Examiner is encouraged to call the undersigned attorney, for counsel will gladly cooperate with the Examiner in any reasonable way that will advance the prosecution of this case to successful conclusion.

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Date

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Respectfully submitted,



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